

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

The sole issue for consideration is the rejection of claims 1-5 under 35 USC § 103(a) as being obvious over Hoffman, US 5,562,789, in view of Treleaven, US 6,413,345. In response, Applicants submit that the cited combination of references does not make out a *prima facie* case of obviousness. Moreover, the present invention is, in any event, characterized by unexpected results already of record. Consequently, Applicants further submit that the Examiner would be fully justified to reconsider and withdraw this rejection.

The Examiner concedes that Hoffmann does not disclose the diecut configuration required by the instant claims. In order to bridge this gap, the Examiner relies on Treleaven, which the Examiner says shows a saw-toothed diecutted tear line in Figure 2. The Examiner says that it would have been an obvious matter of design choice to employ a saw-tooth diecut pattern, as taught by Treleaven, in the labels of Hoffmann, but does not give any reason why persons skilled in the art would have been motivated to do so. Applicants respectfully submit that the mere fact that a saw-tooth diecut pattern was known in the prior art is not, in and of itself, a reason for employing it in Hoffmann's labels. The Examiner does not point to any advantage of such a pattern over a straight-line die-cut, or to anything else that could have been said to have motivated persons skilled in the art actually to make such a substitution. In the absence of such evidence of motivation, Applicants submit that the combination of Hoffmann and Treleaven does not make out a *prima facie* case of obviousness.

At best, all the Examiner has done is to show Applicants' individual elements to be within the prior art. However, the Examiner has not provided any reason why a person having ordinary skill in the art actually would have been motivated to use a saw-

tooth diecut pattern in Hoffmann's labels. As reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

"The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination."

The present rejection is devoid of anything suggesting the desirability of the proposed combination. Merely showing saw-tooth diecuts were known in the prior art, and, therefore, could be selected if one wanted to use that design, is not sufficient to establish a desirability to substitute one design (saw-tooth diecut) for another (straight-line) or, therefore, to evidence the motivation of one of ordinary skill in the art actually to make the substitution.

Further, the Examiner takes the position that employing an anti-adhesive coating on both sides of a backing material is well known and conventional in the art, and, thus, it would have been obvious to employ an anti-adhesive coating on both sides of the backing of Hoffmann as modified by Treleaven. However, as the Federal Circuit noted in *In re Sang-Su Lee*, "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record." See *In re Sang-Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). This mandate applies with equal force to the Examiner. Consequently, this rejection also lacks adequate support for employing an anti-adhesive coating on both sides of the backing material, as required by claim 5.

Finally, assuming for the sake of argument that a *prima facie* case of obviousness had been made out, Applicants point out that the specification contains comparative data proving an unexpected result, which data are, therefore, objective evidence of

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nonobviousness. In this regard, Applicants would call the attention of the Examiner to the Example, which begins on page 23 of the specification. **The Examiner's attention is especially directed to the discussion at page 25, lines 10-30.** Simply put, the requirement of the instant claims that the diecutting line is a non-branching line having a form other than that of a straight line is much more than a simple design choice. The use of the inventive form has the surprising effect of *increasing the speed* with which the diecuts can be applied. As taught at page 25, lines 10-12, straight-line diecuts can be dispensed from a device at a maximum rate of *0.3 m/s*. In contrast, as taught at page 25, lines 13-15, a corresponding undular diecut can be dispensed from the same device at a much higher maximum rate of *2.0 m/s*. Speed of application is, of course, an important parameter in practice. Accordingly, the difference shown is of great practical effect. There is absolutely nothing in the combination of Hoffmann and Treleven that teaches or suggests that use of an undular diecut form as opposed to a straight-line diecut form should increase the speed of application of the diecuts. Yet, this is exactly what the data in the instant specification prove happens. Further, the explanation at page 25, lines 16-30, provides a reasonable basis for concluding that the data are representative of the full breadth of the claims. Indeed, the specification teaches at page 25, lines 16-18, that "[t]he comparison shows that 'non-straight' cross-diecutting forms permit a faster application of the diecuts in contrast to a straight form of the diecutting line." Again, the combination of Hoffmann and Treleven is completely silent as to such a benefit. Accordingly, the data in the specification must be considered to be surprising, and, thus, unexpected, and, therefore, as objective evidence of the nonobviousness of the instant claims. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

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Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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